

RESPONSE

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Applicant(s): Conrad V. ANDERSON et al.

Serial No.: 09/626,621

Confirmation No.: 2487

Filed: 27 July 2000

For: GRAPHIC IMAGE FILM REGISTRATION SYSTEMS AND METHODS

Claims 1, 23, and 26

Applicants respectfully traverse the rejection of independent claims 1, 23, and 26, and respectfully submit that the cited documents fail to support a proper *prima facie* case of obviousness, as follows.

It is asserted in the Office Action that "the instant specification teaches that previously a composite image was formed on the surface of a substrate manually by a skilled applicator who would pull or stretch each film slightly, thus varying the tension, as it was being applied to a registration between the different panels used to form the composite image." However, "[t]he admitted prior art does not teach using registration marks on the film and aligning those registration marks up" (Office Action, page 2). It is also asserted that Krawczyk discloses a method of mounting multiple plastic sheets where . . . each portion has guidelines thereon for which are used to help align the design properly." It is concluded in the Office Action that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to include guides or registration marks in the method of the admitted prior art, because [for] a skilled artisan . . . there are instances where guidelines or registration marks would be helpful in aligning images on separate sheets as taught by Krawczyk."

It is conceded in the Office Action that "[t]he admitted prior art in view of Krawczyk does not teach varying the tension on the second film along the length of the film to help ensure the marks are aligned properly", but that because Jensen "teaches . . . ways of aligning webs" it would have been "obvious to one having ordinary skill in the art at the time the invention was made to vary the tension on the length second web thus stretching or shrinking the space between the registration marks."

Applicants respectfully traverse these assertions and submit that the documents cited in the Office Action fail to support a proper *prima facie* case of obviousness. For example, the cited documents fail to support the asserted suggestion or motivation to modify or combine the reference teachings, because the proposed combination would change the principle operation of

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the prior art invention being modified. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious (M.P.E.P. 2143.01). Applicants' analysis as to how the proposed modification or combination of the prior art changes the principle of operation of the prior art is presented below.

Krawczyk teaches that "items to be subsequently mounted" are packaged in "plastic sheets" where "one sheet includes an adhesive layer that adheres to the front face of the item" (Abstract). Krawczyk recognizes that "added care must be used when urging the sheet 12 against loose pieces so as not to change the relative position of the various tile pieces" (Col. 7, lines 51-56). In other words, Krawczyk teaches that it is undesirable to change the relative positions of the tile pieces.

Applying the teachings of Jensen to Krawczyk as asserted in support of this rejection would, however, necessarily result in changing the relative positions of the tile pieces as the sheet 12 was stretched as taught by Jensen. This would result in a distorted composite image for Krawczyk, a result which Krawczyk teaches is undesirable. Thus, the proposed combination of Jensen with Krawczyk would change the principle of operation of at Krawczyk, and as such the teaching of the references are not sufficient to render the claims *prima facie* obvious.

Applicants respectfully request reconsideration and allowance of claims 1, 23, and 26.

Claims 2-8, 13-19, 24, 25, and 27-33

Applicants respectfully traverse the rejection of claims 2-8, 13-19, 24, 25, and 27-33, as follows.

For claim 2, Applicants respectfully submit that the Office Action does not present a proper *prima facie* case of obviousness as the Office Action did not explain with reasonable specificity the grounds for the obviousness rejection of claim 2. In particular, the Office Action did not explain with reasonable specificity what portions of the cited documents were relied upon

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for teaching or suggesting that the tension under which the second film is dispensed is continuously applied to the second film during the dispensing, as recited in claim 2.

In addition, the cited documents fail to support a proper *prima facie* case of obviousness for claim 2. For example, the cited documents fail to teach or suggest all the elements of claim 2. In particular, the cited documents fail to teach or suggest that the tension under which the second film is dispensed is continuously applied to the second film during the dispensing, as recited in claim 2.

For claims 3-5, 13, 15, 16, 32, and 33, Applicants respectfully submit that each claim is a dependent claim of either independent claim 1 or 26. Applicants respectfully repeat the arguments presented above for independent claims 1 and 26 that the cited documents fail to support a proper *prima facie* case of obviousness. As such, the Office Action fails to establish a *prima facie* case of obviousness for the rejection of claims 3-5, 13, 15, 16, 32, and 33.

For claims 6-8, 24, and 25 Applicants respectfully submit that the Office Action does not present a proper *prima facie* case of obviousness as the Office Action did not explain with reasonable specificity the grounds for the obviousness rejection of claims 6-8, 24, and 25. In particular, the Office Action did not explain with reasonable specificity what portions of the cited documents were relied upon for teaching or suggesting that at least some of the second registration marks were removed from the second film, as recited in claim 6; that removing comprises removing a portion of the second film, as recited in claims 7 and 24; or that removing occurs before the second film is applied to the substrate, as recited in claims 8 and 25.

In addition, the cited documents fail to support a proper *prima facie* case of obviousness for claims 6-8, 24, and 25. For example, the cited documents fail to teach or suggest all the elements of claims 6-8, 24, and 25. In particular, the cited documents fail to teach or suggest that at least some of the second registration marks are removed from the second film, as recited in claim 6; the cited documents fail to teach or suggest that removing the second registration marks from the second film comprises removing a portion of the second film, as recited in claims 7 and

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24; and the cited documents fail to teach or suggest that removing the second registration marks from the second film occurs before the second film is applied to the substrate, as recited in claims 8 and 25.

For claim 14, Applicants respectfully submit that the Office Action does not present a proper *prima facie* case of obviousness as the Office Action did not explain with reasonable specificity the grounds for the obviousness rejection of claim 14. In particular, the Office Action did not explain with reasonable specificity what portions of the cited documents were relied upon for teaching or suggesting that the first and second registration marks are distributed in regular intervals, as recited in claim 14.

In addition, the cited documents fail to support a proper *prima facie* case of obviousness for claim 14. For example, the cited documents fail to teach or suggest all the elements of claim 14. In particular, the cited documents fail to teach or suggest that the first and second registration marks are distributed in regular intervals, as recited in claim 14.

For claims 17 and 18 Applicants respectfully submit that the Office Action does not present a proper *prima facie* case of obviousness as the Office Action did not explain with reasonable specificity the grounds for the obviousness rejection of claims 17 and 18. In particular, the Office Action did not explain with reasonable specificity what portions of the cited documents were relied upon for teaching or suggesting registering a first and second portions of a composite image across the widths of the first and second films, as recited in claim 17; and what portions of the cited documents were relied upon for teaching or suggesting detecting a distance between a leading edge and a trailing edge of the second registration marks, wherein that distance is indicative of a position across the width of the second film, as recited in claim 18.

In addition, the cited documents fail to support a proper *prima facie* case of obviousness for claims 17 and 18. For example, the cited documents fail to teach or suggest all the elements of claims 17 and 18. In particular, the cited documents fail to teach or suggest registering a first and second portions of a composite image across the widths of the first and second films, as

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recited in claim 17; and detecting a distance between a leading edge and a trailing edge of the second registration marks, wherein that distance is indicative of a position across the width of the second film, as recited in claim 18.

For claim 19, Applicants respectfully submit that the Office Action does not present a proper *prima facie* case of obviousness as the Office Action did not explain with reasonable specificity the grounds for the obviousness rejection of claim 19. In particular, the Office Action did not explain with reasonable specificity what portions of the cited documents were relied upon for teaching or suggesting that providing the first film on the substrate comprises applying the first film to the substrate under tension, as recited in claim 19.

In addition, the cited documents fail to support a proper *prima facie* case of obviousness for claim 19. For example, the cited documents fail to teach or suggest all the elements of claim 19. In particular, the cited documents fail to teach or suggest that providing the first film on the substrate comprises applying the first film to the substrate under tension, as recited in claim 19.

For claims 27-31, Applicants respectfully submit that the Office Action does not present a proper *prima facie* case of obviousness as the Office Action did not explain with reasonable specificity the grounds for the obviousness rejection of claims 27-31. In particular, the Office Action did not explain with reasonable specificity what portions of the cited documents were relied upon for teaching or suggesting that the first and second registration marks are invisible, as recited in claim 27; that the second registration marks are invisible, as recited in claim 28; that the second registration marks are washable, as recited in claim 29; that the first and second films are provided in roll form, as recited in claim 30; and that the lengths of the first and second films are at least as great as the length of the composite image, as recited in claim 31.

In addition, the cited documents fail to support a proper *prima facie* case of obviousness for claims 27-31. For example, the cited documents fail to teach or suggest all the elements of claims 27-31. In particular, the cited documents fail to teach or suggest that the first and second registration marks are invisible, as recited in claim 27; that the second registration marks are

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invisible, as recited in claim 28; that the second registration marks are washable, as recited in claim 29; that the first and second films are provided in roll form, as recited in claim 30; and that the lengths of the first and second films are at least as great as the length of the composite image, as recited in claim 31.

Applicants respectfully request reconsideration and allowance of claims 2-8, 13-19, 24, 25, and 27-33.

Claims 9-12

It is asserted in the Office Action that "[r]egarding claims 9-12, invisible and washable registration marks are within the purview of one having ordinary skill in the art, because it would be preferable that the alignment marks not be intrusive to the composite image." Applicants respectfully traverse these assertions and request one or more documents in support of the assertions as required by M.P.E.P. 2144.03.

Claims 20-22

For claims 20-22, Applicants respectfully submit that claims 20-22 are dependent claims of independent claim 1. Applicants respectfully repeat the arguments presented above for independent claim 1 that the cited documents fail to support a proper *prima facie* case of obviousness and that a proper *prima facie* case of obviousness has not been presented in the Office Action. As such, the Office Action fails to establish a *prima facie* case of obviousness for the rejection of claims 20-22.

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Summary

It is respectfully submitted that the pending claims 1-33 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 20th day of June, 2002, at 1:32 p.m. (Central Time).

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